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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,118	04/14/2004	Haimanot Bekele	9209M	6444

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THE PROCTER & GAMBLE COMPANY
INTELLECTUAL PROPERTY DIVISION - WEST BLDG.
WINTON HILL BUSINESS CENTER - BOX 412
6250 CENTER HILL AVENUE
CINCINNATI, OH 45224

EXAMINER	
MAHYERA, TRISTAN J	
ART UNIT	PAPER NUMBER
4173	

MAIL DATE	DELIVERY MODE
12/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/824,118	BEKELE ET AL.	
	Examiner	Art Unit	
	TRISTAN J. MAHYERA	4173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 October 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) *18-21* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17 and 22-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *1/28/2005, 12/10/2004, 10/04/2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I in the reply filed on 10/04/2007 is acknowledged. The traversal is on the ground(s) that Group I and Group II are not independent because the compositions and methods set forth in the claims are so closely related that a search for applicants' elected composition/kit claims would necessarily encompass a search for the method claims of examiner's Group II. Additionally, applicants argue that a search directed to both the compound/kit claims and to the method claims would not be a serious burden. These arguments are not found persuasive for the following reasons.

Group I is directed to a composition/kit comprising modified silicones, organosiloxane resin and a volatile carrier. The search of modified silicones and an organosiloxane resin in conjunction with the requirement of a kit is not coextensive with the search of Group II because an additional structure and text search is necessary. Anytime multiple databases or divergent search strings are necessary a burden is demonstrated. Additionally, since actually conducting the search on Group I, the additional required elements of Group II were not found in any of the prior art of record indicating that an additional search would be necessary and a serious burden. Applicants' traversal of the restriction between Group I and Group II is not deemed persuasive. The search for the composition and the search for the process of applying the composition are not coextensive because the steps to search for modified silicones

and organosiloxane resins as claimed requires a search of the structure whereas the search for the process of applying said composition/kit requires a text search of the method steps. Applicants' traversal of the restriction between Group I and Group II is not deemed persuasive.

The requirement is still deemed proper and is therefore made FINAL.

Applicant's election with traverse of the following species in the reply filed on 10/04/2007 is acknowledged:

(a) Modified silicone - aminosilicone;

(b) Organosiloxane resin - an organosiloxane resin comprising $R_3SiO_{1/2}$ "M" units and SiO_2 "Q" units, wherein the ratio of $R_3SiO_{1/2}$ to SiO_2 is about 0.7;

(c) Diorganosiloxane polymer - Polydimethylsiloxane;

(d) Volatile carrier - isododecane; and

(e) Thickeners/structure builder - organically modified clay, e.g., organically modified bentonite.

Applicant's traversal is on the grounds that a single search with regard to the modified silicone, organosiloxane resin, diorganosiloxane polymer and volatile carrier should reveal all of the most relevant art. This is not found persuasive because the species as claimed are patentably distinct, each from the other for the reasons of record as stated in the last office action. Furthermore, the search of the entire groups in the non-patent literature (a significant part of thorough examination) would be burdensome. Furthermore, applicant's traversal is on the grounds that searching all claims does not impose an undue burden. This is not found persuasive because the species above are

patentably distinct. The search for each of the above species is not co-extensive particularly with regard to the literature search. Burden consists not only of searching of multiple databases for foreign references and literature searches. Burden also resides in the examination of independent claim sets for clarity, enablement and double patenting issues. Further, a reference that would anticipate the invention of one group would not necessarily anticipate or even make obvious another group. The consideration for patentability is different in each case. Thus, it would be an undue burden to examine all of the above inventions in one application and the species election requirement with regard to (a)-(d) is still deemed proper and is therefore made FINAL.

Applicants' traversal of (e)thickeners/structure builders has been considered and the species election is **withdrawn**.

Status of Claims

Claims 1-24 are pending. Claims 18-21 are withdrawn as being drawn to the non-elected invention. Claims 1-17 and 22-24 are examined on the merits.

Priority

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

Specification

The use of the trademarks WACKER 803/804, PERMETHYL 99A, CARBOWAX, ROSSWAX, GLOSSAMER L-6600, BENTONE GEL ISD and FLAMENCO SUPERPEARL, have been noted in this application (see page 4 line 12; page 5 line 24, page 7 line 28 and line 31; page 9 line 11; page 10 line 28, page 11 lines 7, 8, 11 and 22; page 12 lines 1, 2, 28, 29 and 33). A trademark should be capitalized wherever one appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by DRECHSLER et al (US 6,139,823, see PTO-1449 dated 12/10/2004).

DRECHSLER teaches a cosmetic composition comprising an organosiloxane resin, a diorganosiloxane polymer and a volatile carrier. See e.g. col 1 lines 15-17; instant claims 1 and 7. Modified silicones, specifically aminosilicones, i.e. the amino alkyl side of silicone are used in the cosmetic composition. See e.g. claim 6 (amino alkyl side of silicone); instant claim 1. The use of organosiloxane resin is exemplified in claim 1 line 7; instant claim 1. Volatile carrier is taught in claim 1 line 12. Example 6 is anhydrous, as no water is used. See example 6, col 19; instant claim 1. Examples of thickeners used are propylene carbonate and bentonite clay. See e.g. example 29 col 34 line 66 to col 35 line 1; example 29 col 34 line 48; instant claims 2, 3 and 4. The organosiloxane resin comprises $R_3SiO_{1/2}$ "M" units, $R_2SiO_{1/2}$ "D" units, $RSiO_{3/2}$ "T" units and SiO_2 "Q" units, to satisfy the relationship $R_nSiO_{(4-n)/2}$ where n is from about 1.0 to about 1.50 and R is a methyl group. See e.g. claim 3; instant claim 5. The organosiloxane resin also comprises $R_3SiO_{1/2}$ "M" units and SiO_2 "Q" units, wherein the ratio of $R_3SiO_{1/2}$ to SiO_2 is about 0.7. See e.g. claim 7; instant claim 6. The use of the term "about" in the instant invention broadens the range of the ratio and is anticipated by the about 0.6 of the prior art. The diorganopolysiloxane polymer is polydimethyl siloxane. See e.g. claim 8; instant claims 7-11. The modified silicone has a viscosity of from about 100 cSt to about 2,000,000 cSt at 25 degrees C. See e.g. claim 11 line 4; instant claims 12 and 13. The volatile carrier is selected from the group consisting of hydrocarbon oils, silicone oils and mixtures thereof. See e.g. claim 17; instant claim 14.

The volatile carrier is specifically isododecane. See e.g. claim 18; instant claim 15. A topcoat is added over the composition. See e.g. col 10 lines 48-65; instant claim 17.

Claim 16 recites the composition of claim 1 as having a viscosity from about 500 cP to about 15,000 cP. While this is not specifically stated in the prior art the properties of the composition recited by Applicants are reasonably deemed to be present in the composition suggested by the prior art, because the components are the same. It is noted that *In re Best* (195 USPQ 430) and *In re Fitzgerald* (205 USPQ 594) discuss the support of rejections wherein the prior art discloses subject matter in which there is reason to believe inherently includes functions that are newly cited or are identical to a product instantly claimed. In such a situation the burden is shifted to the applicants to "prove that subject matter shown to be in the prior art does not possess characteristic relied on" (205 USPQ 594, second column, first full paragraph).

Therefore, each and every limitation of the claims given patentable weight is met by the reference.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 17-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over DRECHSLER in view of NICHOLS (US 6,010,709- see PTO-892).

DRECHSLER teaches a cosmetic composition comprising an organosiloxane resin, a diorganosiloxane polymer and a volatile carrier, as described above.

DRECHSLER does not explicitly teach the use of a kit nor does it teach that the topcoat composition is selected from aminosilicones, carboxy modified silicones, epoxy modified silicones and mixtures thereof.

NICHOLS teaches the use of a kit and composition to enhance the appearance of the lips. See e.g. col 1 lines 13-19; instant claims 22-24.

Claim 17 recites a topcoat composition. The components are known in DRECHSLER, however, not specifically as a topcoat. "It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art." In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). In this case, a person having ordinary skill in the art would have known to use aminosilicones, for example, as a topcoat because its properties and purpose for inclusion in a lip composition would be the same.

It would have been obvious to one of ordinary skill in the art at the time of the invention to practice a cosmetic composition containing modified silicones, organosiloxane resin and a volatile carrier in a kit, which includes a topcoat composition because DRECHSLER teaches it is within the skill of the art to use modified silicones to improve the luster or smear resistance of lip compositions and because NICHOLS teaches it is within the skill of the art to have a cosmetic composition in a kit with a topcoat composition. One would have been motivated to do so in order to receive the expected benefit, as suggested by DRECHSLER and actually exemplified by NICHOLS. Absent any evidence to the contrary, and based upon the teachings of the prior art, there would have been a reasonable expectation of success in practicing the instantly claimed invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tristan J. Mahyera whose telephone number is 571-270-1562. The examiner can normally be reached on Monday through Thursday 9am-4pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/TJM/

/Cecilia Tsang/
Supervisory Patent Examiner, Art Unit 4173